

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN C. TRASK

Appeal No. 2004-1408
Application No. 10/166,590

ON BRIEF

Before PAK, OWENS, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 27 and 30 (final Office action mailed May 1, 2003, paper 5) in the above-identified application. Claims 21 through 26, 28, 29, and 31 through 40, which are the only other pending claims, are either allowed or objected to as being dependent on a rejected base claim. (Examiner's answer mailed Nov. 13, 2003, paper 8, page 3; final Office action, pages 2-3.)

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The subject matter on appeal relates to an adjustable support for a bicycle seat. According to the present specification (¶2), the claimed invention "is directed to a seat post for a bicycle that is safely adjustable in elevation while riding the bicycle." Further details of this appealed subject matter are recited in claims 27 and 30, the only claims on appeal, reproduced below:

27. An adjustable support for a bicycle seat, comprising:

a seat post capable of attachment in telescopic and vertically adjustable relation to a frame member of said bicycle;

a retaining mechanism configured and arranged releasably to hold said seat post in a plurality of fixed vertical positions relative to said frame member, said fixed vertical positions comprising a first holdable position and a second holdable position immediately adjacent to said first holdable position and spaced apart from said first holdable position by a distance greater than about 2 inches to provide an elevation change for said seat between an ergonomic pedalling height at said first holdable position and a reduced height at said second holdable position, said elevation change being operable to permit a rider to shift a center of gravity of said rider downward and rearward with respect to said bicycle to increase stability of said rider while descending a hill; and

a release mechanism, safely operable while a rider is in the act of riding said bicycle, said release mechanism being operable to release engagement between said retaining mechanism and said seat post to permit an adjustment in elevation of said seat post with respect to said frame member.

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30. The support of claim 27, further comprising:
alignment structure adapted to maintain said seat
in an approximately forward facing direction during
changes of elevation of said seat.

The examiner relies on the following prior art reference as
evidence of unpatentability:

Cienfuegos	4,150,851	Apr. 24, 1979
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Claims 27 and 30 on appeal stand rejected under 35 U.S.C.
§ 103(a) as unpatentable over Cienfuegos. (Answer, pages 3-4;
final Office action, page 2.)

We affirm. Because we are in complete agreement with the
examiner's factual findings and legal conclusions, we adopt them
as our own and add the following comments for emphasis.¹

Cienfuegos describes a height-adjustable hollow seat post
assembly (i.e., an adjustable support) for bicycles,
motorcycles, and stationary pedal actuated cycle-type exercise
machines. (Column 1, lines 3-49.) According to the reference,
the adjustable support allows the seat to be "adjusted with
respect to height while the machine is being used." (Column 1,

¹ While the appellant submits that claims 27 and 30 do not stand
or fall together (appeal brief filed Jul. 3, 2003, paper 7, p. 3), the
appeal brief does not contain any argument in support of the separate
patentability of claim 30 relative to claim 27. Accordingly, the
examiner correctly held that claims 27 and 30 stand or fall together.
(Answer, p. 3.) In our discussion of the rejection, we select claim
27 as representative and decide this appeal on the basis of this claim
alone. 37 CFR § 1.192(c)(7) (2003) (effective Apr. 21, 1995).

lines 50-52.) Specifically, Cienfuegos teaches that the "seat post is insertable inside a hollow frame seat post and the seat post is just large enough for an easy sliding fit inside the frame seat post" (column 1, lines 29-32), thus indicating to one of ordinary skill in the art that the "seat post is capable of attachment in telescopic and vertically adjustable relation to a frame member of" the bicycle as recited in appealed claim 1. In addition, Cienfuegos teaches that the seat post assembly includes a seat post 16 having tine 23 provided with longitudinally spaced height adjusting holes 30, a frame seat post 14 provided with a locking pin receiving hole 36, a first coil spring 24, a simple pin 26 inserted diametrically through the bottom of the frame seat post 14 for supporting the lower end of coil spring 24, a simple pin 34 extending through hole 32 and locked to the frame seat post 14, an aligning pin receiving groove 22, and a spring actuated locking pin 38 mounted on the frame for penetrating holes 30 and 36. (Column 1, line 66 to column 2, line 49; Figure 1-4.) Cienfuegos further teaches an operating handle (i.e., a release mechanism) that can be actuated safely. (Column 2, lines 52-64.)

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Regarding the advantages of the disclosed adjustable support, Cienfuegos teaches that the seat post assembly can be used on an "exercycle," which "is used by large numbers of different people during the course of the day, and the adjustable seat provides a simple way to conveniently vary the seat height in accordance with the requirements of the various users." (Column 3, lines 1-5.) When used on a bicycle, the disclosed adjustable support is said to be "useful because the best seat height for riding a bicycle is not always the best height for getting off while the bicycle is stopping." (Column 3, lines 26-57.)

The adjustable support disclosed in Cienfuegos differs from the invention recited in appealed claim 27 only in that the distance between the longitudinally spaced height adjusting holes 30 is not specified. As we pointed out above, however, Cienfuegos teaches that various users of an "exercycle" have different heights and that "the adjustable seat provides a simple way to conveniently vary the seat height in accordance with the requirements of the various users." (Column 3, lines 1-5.)

Because the heights of various individuals in the general population vary considerably (i.e., significantly more than 2 inches), one of ordinary skill in the art would have found it prima facie obvious to select any suitable distance (e.g., about 2 inches), including an optimum or workable distance, between the longitudinally spaced height adjusting holes 30 to provide "a simple way to conveniently vary the seat height in accordance with the requirements of the various users." In re Peterson, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003) ("The normal desire of scientists or artisans to improve upon what is generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."); In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) ("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.").

Once a prima facie case of obviousness is established, the burden of proof is shifted to the applicant to show that the

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claimed invention would not have been obvious (e.g., by presenting persuasive argument or objective evidence of unexpected results commensurate in scope with the claims). In re Peterson, 315 F.3d at 1330, 65 USPQ2d at 1383; In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Mayne, 104 F.3d 1339, 1343, 41 USPQ2d 1451, 1455 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

The appellant argues that the claimed invention is directed to solving a different problem (changing an elevation of a bicycle rider's center of gravity to increase stability of the rider when riding down a hill) than the problem addressed in the reference (adjusting an "excercise" or bicycle seat elevation to a comfortable or ergonomic pedaling height to accommodate various riders having legs of different lengths). (Appeal brief, page 4.) We, like the examiner, are unpersuaded. Cienfuegos discloses an adjustable seat support for accommodating various riders with legs of different lengths. But when installed on a bicycle that is operated down a hill, Cienfuegos's adjustable seat support will necessarily operate to

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change the elevation of the rider's center of gravity. Thus, the appellant on this record has failed to establish that the claimed support is structurally different from the prior art support. Cf. In re Schreiber, 128 F.3d 1473, 1474, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). In any event, the recitation of an additional advantage to using an apparatus suggested in the prior art does not lend patentability to an otherwise unpatentable invention. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983); In re Wiseman, 596 F.2d 1019, 1023, 201 USPQ 658, 661 (CCPA 1979); In re Kronig, 539 F.2d 1300, 1304, 190 USPQ 425, 427-28 (CCPA 1976); In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562-63 (CCPA 1972).

The appellant contends "that the size of the recited spacing between holding positions is of first order importance to the operation of the invention, and is neither disclosed nor suggested in the reference." (Appeal brief, page 4.) We see no merit in this contention. The appellant has failed to identify any evidence in the record to substantiate any criticality for the recited spacing size, much less any unexpected result relative to the closest prior art. In re Wiseman, 596 F.2d at 1022-23, 201 USPQ at 661.

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The appellant alleges that a "smaller gap, as proposed in the rejection, would not provide the desired drop in the rider's center of gravity." (Appeal brief, page 5; see also reply brief filed Jul. 3, 2003, paper 9, page 2.) We note, however, Cienfuegos would have suggested the same (not "smaller") spacing size for holes 30 because one of ordinary skill in the art would have selected any suitable spacing size including the here recited "greater than about 2 inches." Here, one of ordinary skill in the art would have determined through routine experimentation that a spacing size of about 2 inches for holes 30 would permit the seat to be adjusted in increments of about 2 inches, thus accommodating at least two riders whose leg lengths differ by about 2 inches. Nothing substantiates the appellant's allegation (reply brief, page 2) that a spacing size of "about two inches" would be unsuitable for the purpose disclosed in Cienfuegos.

For these reasons and those set forth in the answer, we affirm the examiner's rejection under 35 U.S.C. § 103(a) of appealed claims 27 and 30 as unpatentable over Cienfuegos.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

Chung K. Pak)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Terry J. Owens)	
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